

### REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 27-38 are canceled, Claims 39-50 are added, and no claims are amended. Hence, Claims 1, 3-13, and 39-50 are pending in the application.

#### **I. SUMMARY OF THE TELEPHONE INTERVIEW**

The Examiner is thanked for the telephone interview conducted on August 10, 2009. In the interview, Applicant's representatives discussed the differences between Claim 1 and the cited art. The Examiner agreed that the cited art does not teach or suggest all the limitations of Claim 1 and that a new search would be required.

#### **II. SUMMARY OF THE REJECTIONS**

Claims 1, 3-8, 10, 11, 13, 28-33, 35, and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,154,740 issued to Shah ("*Shah*") in view of U.S. Patent No. 6,154,740 issued to Tran et al. ("*Tran*"). This rejection is respectfully traversed.

Claims 9 and 34 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Shah* in view of *Tran*, and further in view of U.S. Patent Publication No. 2002/0023004 to Hollander et al. ("*Hollander*"). This rejection is respectfully traversed.

Claims 12 and 37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Shah* in view of *Tran*. This rejection is respectfully traversed.

#### **III. THE REJECTIONS BASED ON THE CITED ART**

Claims 1, 3-8, 10, 11, 13, 28-33, 35, and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Shah* in view of *Tran*.

A. CLAIM 1

Claim 1 recites:

A method of depicting a plurality of items and how said plurality of items satisfy multiple criteria, the method comprising the computer-implemented steps of:  
a browser receiving a page; and

**in response to executing said page, said browser performing the steps of:**

generating a display of a list of visual indicators in a particular order,  
wherein the particular order indicates how said plurality of items satisfy a first criteria;

detecting input indicating the selection of one or more second criteria;

in response to detecting said input, determining, without said browser

having to interact over a network with a server, how said plurality of items satisfy the one or more second criteria; and

**while retaining said list of visual indicators in said particular order within said display, displaying a visual indication of how said plurality of items satisfy the one or more second criteria.**

(emphasis added)

The combination of *Shah* and *Tran* fails to teach or suggest all the features of Claim 1.

1. *The cited art fails to teach or suggest “while retaining said list of visual indicators in said particular order within said display, displaying a visual indication of how said plurality of items satisfy the second criteria”*

The Office Action cites col. 1, lines 33-45 of *Shah* for allegedly disclosing “while retaining said list of visual indicators in said particular order within said display, displaying a visual indication of how said plurality of items satisfy the second criteria” as recited in Claim 1.

This is incorrect. That cited portion states:

The capability to sort lists based on a hierarchy of key fields or other sort parameters is generally not currently available. For example, a first level sort may be desired by name. Then, a second level sort within the first level sort (i.e.,

within each grouping of names) using date as a sort parameter may be desired. Additionally, a third level sort, such as time, within the first and second levels may be desired. Clearly, the ability to accomplish many levels of sorting within easily "nested" sort parameters is attractive to a broad set of users. Accordingly, what is needed in the art is a way to sort and display lists to improve their readability and useability.

This merely states that lists may be sorted in multiple ways. In the example above, a list is sorted by name (i.e., the alleged one or more first criteria). Then, within each grouping of names (e.g., all names that start with "A"), the list is sorted by date (i.e., the alleged one or more second criteria). For example, a list of emails is first sorted by the name of the sender. Then all the emails with sender names that begin with "A" are sorted by date. Thus, the emails with sender names that begin with "A" are **rearranged** to be sorted by date. In other words, the order in which the emails appeared after the alphabetical sorting is **not** retained when the second level date sort is applied, as Claim 1 would require. Thus, *Shah* fails to teach or suggest "while retaining said list of visual indicators in said particular order within said display, displaying a visual indication of how said plurality of items satisfy the second criteria."

2. *The cited art fails to teach or suggest a browser performing steps in response to executing a self-contained page*

On page 4, the Office Action concedes that "Shah fails to teach a browser receiving a self-contained page; which does not have to interact over a network with a server." It is respectfully submitted that *Shah* fails to teach more than that recited in Claim 1. Indeed, *Shah* fails to teach or suggest that the steps of generating, detecting, determining, and displaying are performed (1) by a browser and (2) in response to executing a page.

The Office Action then cites col. 6, lines 19-34 of *Tran* for teaching "a browser receiving a self-contained page, and does not have to interact over a network with a server."

First, it is respectfully noted that Claim 1 no longer recites a self-contained page. Second, the cited portion of *Tran* merely states:

In one embodiment, the Internet file 36 is a self-contained executable **applet** that may be transferred and displayed on the Internet 16 by a standardized browser.

This minimizes the resource requirements for the browser but results in an enlarged and customized file. In addition, as new features are added, those features are provided by the applet and are therefore independent of the browser.

In another embodiment, Internet file 36 may be a smaller script file that is loaded and played by an applet player. In this embodiment, the output player needs to contain all the features that it expects to play regardless of whether the script file utilizes those features. In addition, the applet player may only display what it is designed to present and a new applet player must be generated and downloaded for new features to be available. (emphasis added)

Fundamentally, *Tran* fails to teach or suggest a page, much less a browser executing a page. Therefore, even if *Shah* did teach the steps of generating, detecting, determining, and displaying, the combination of *Shah* and *Tran* still fails to teach or suggest that a browser performs those steps while executing a page.

*Tran* only teaches that a browser may display an applet. As is well known in the art, an applet is a program that executes within another application, such as a browser, and performs one or more specific functions. Even if *Shah* and *Tran* could be combined, the combination would result in the **applet** performing certain steps, not the browser, as Claim 1 requires. Indeed, a page is **not** an applet. In all, neither *Shah* nor *Tran* teach or suggest that a browser performs certain steps in response to executing a page.

Based on the foregoing, *Shah* and *Tran* fail to teach or suggest, both individually and in combination, all the features of Claim 1. Therefore, Claim 1 is patentable over *Shah* and *Tran*.

Reconsideration and withdrawal of the rejection of Claim 1 under 35 U.S.C. § 103(a) is therefore respectfully requested.

3. *One of ordinary skill in the art would not combine Shah and Tran*

Regardless of whether *Shah* and *Tran* individually teach or suggest all the features of Claim 1, one of ordinary skill in the art would not combine *Shah* and *Tran*. After citing *Tran* for disclosing certain features of Claim 1, the Office Action asserts, “Therefore, it would have been obvious to an artisan at the time of the invention to combine the teaching of [Shah] with the method of Tran. Since both the sorting method of Shah and a self-contained browser applet of Tran were both known in the prior art and both references use client-side application software, combining the prior art elements to the known methods would have yielded predictable results. The combination would have yielded the claimed method.” (pages 3-4). This is incorrect.

MPEP § 2143.01(IV) requires “some objective reason to combine the teachings of the references.” There is no reason to combine *Shah* and *Tran* because, other than discussing computer systems and displaying data, *Shah* and *Tran* are completely unrelated to each other. *Shah* teaches a method of (1) scanning a key field of a sorted list; (2) determining sort points in the key field; (3) associating marks with the key field based on the sort-points; and (4) displaying the sorted list. In contrast, *Tran* teaches a system for converting (a) dynamic content generated in a non-Internet format (by a general purpose application) into (b) an Internet format that can be transmitted over the Internet (see col. 1, lines 37-41).

Further, one of ordinary skill in the art would not combine *Tran* with *Shah* to arrive at the invention according to Claim 1 because *Tran* is directed to server-side functionality (i.e., relating to the conversion from a non-Internet format to an Internet format), whereas Claim 1 is directed to client-side functionality.

Even if *Shah* and *Tran* were combinable, it is not clear (i) how the combination would be made, (ii) what the combination would be, and (iii) what modifications to each cited reference would have to be made. Instead, the Office Action merely asserts that there are known methods could have been used to combine the prior art without outlining what those “known methods” are. As noted above, *Shah* and *Tran* are completely unrelated to each other. It appears that the rationale for combination in the Office Action is merely a collection of “key” *KSR* phrases, such as “combining prior art elements according to known methods” and “predicable results.”

In fact, the second underlined sentence above from the Office Action is almost an exact copy of exemplary rationale (A) in MPEP § 2143: “Combining prior art elements according to known methods to yield predictable results.”

Further, according to MPEP § 2143(A), the Office Action’s “rationale” for combining *Shah* and *Tran* is incomplete. There are four findings that an Office Action must articulate:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Even if the Office Action successfully made the first finding above, the Office Action fails to articulate any of the other required findings.

B. CLAIM 11

In rejecting independent Claim 11, the Office Action states, “Claim 11 is similar in scope to that of claim 1, and is therefore rejected under similar rationale” (page 6). Simply because Claims 1 and 11 have similar scope does not mean that Claims 1 and 11 have identical scope. In fact, Claim 11 includes multiple features that are absent from Claim 1, such as (1) the recited page elements and (2) the steps of generating the recited page elements that cause or enable a browser to perform certain actions. The Office Action fails to cite any portion of *Shah* and *Tran* for disclosing these features of Claim 11 that are not found in Claim 1. Indeed, *Shah* and *Tran* fail to teach or suggest any of these features of Claim 11 that are not found in Claim 1.

In an Office Action “the particular part relied on must be designated as nearly as practicable ...” (37 C.F.R. § 1.104, MPEP § 707). The failure to specify any specific part of *Shah* or *Tran* that correlates to multiple elements in Claim 11 is tantamount to admitting that *Shah* and *Tran* fail to teach all the limitations of Claim 11. Reconsideration and withdrawal of the rejection of Claim 11 is therefore respectfully requested.

C. CLAIMS 39 AND 48

Claims 39 and 48 are independent claims that recite the same features discussed above for Claims 1 and 11. Therefore, Claims 39 and 48 are patentable over the cited art for at least the same reasons discussed above for Claims 1 and 11.

D. CLAIMS 3-10, 12, 13, 40-47, 49 AND 50

Claims 3-10, 12, 13, 40-47, 49, and 50 are dependent claims, each of which depends (directly or indirectly) on one of the claims discussed above. Each of Claims 3-10, 12, 13, 40-47, 49, and 50 is therefore patentable over the cited art for at least the reasons given above for the claim on which it depends. In addition, each of Claims 3-10, 12, 13, 40-47, 49, and 50 introduces one or more additional limitations that may render it independently patentable. However, due to the fundamental differences already identified and to expedite the positive resolution of this case, a separate discussion of those limitations is not included at this time. The Applicant reserves the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

IV. CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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